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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,258	04/25/2001	Osamu Inoue	10873.707US01	9787

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EXAMINER

NGUYEN, TUYEN T

ART UNIT PAPER NUMBER

2832

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/843,258

Applicant(s)
Inoue et al.

Examiner
Tuyen T. Nguyen

Art Unit
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 1, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2832

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanekiyo et al. in view of Kugimiya et al. [US 5,350,628].

Kanekiyo et al. discloses a magnetic body comprising:

- a composite magnetic body including metallic magnetic powder and thermosetting resin having a packing ratio of the metallic magnetic powder of 65 vol% to 90 vol%.

Kanekiyo et al. discloses the instant claimed invention except for the specific resistivity of the magnetic body.

Kugimiya et al. discloses a magnetic sintered composite material formed of an alloy of Fe-Al-Si having a resistivity of 20MOhms or more.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the composite material design of Kugimiya et al. in the composite body of Kanekiyo et al. for the purpose of improving flux density.

Art Unit: 2832

Regarding claims 6-8, Kanekiyo et al. discloses the instant claimed invention except for the magnetic powder having a thin silicon oxide film formed on a surface thereof.

Kugimiya et al. discloses the magnetic powder having a silicon oxide film formed on the surface thereof.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to use the magnetic particle of Kugimiya et al. in the composite body of JP 2-226799 for the purpose of reducing interference.

The specific thickness of the silicon oxide film, mean particle size, insulating material shape, aspect ratio of the electrical insulating material and the use of organic material with the composite magnetic body would have been an obvious design consideration based on the particular applications and environment of use of the composite magnetic body.

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-226799 in view of Kanekiyo et al. and Kugimiya et al.

JP 2-226799 discloses a magnetic element comprising:

- a composite magnetic body including metallic magnetic powder and thermosetting resin [see abstract] having a ratio of the metallic magnetic powder of 65 vol% to 90 vol%; and

- a coil [1] embedded within the composite magnetic body.

JP 2-226799 discloses the instant claimed invention except for the specific packing ratio and the specific resistivity of the magnetic body.

Kanekiyo et al. discloses a magnetic body comprising:

Art Unit: 2832

- a composite magnetic body including metallic magnetic powder and thermosetting resin having a packing ratio of the metallic magnetic powder of 65 vol% to 90 vol%.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to use the packing ratio of Kanekiyo et al. in JP 2-226799 for the purpose of enhancing the magnetic field.

JP 2-226799 in view of Kanekiyo et al. discloses the instant claimed invention except for the specific resistivity of the magnetic body.

Kugimiya et al. discloses a magnetic sintered composite material formed of an alloy of Fe-Al-Si having a resistivity of 20MOhms or more.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to use the composite material design of Kugimiya et al. in the composite body of JP 2-226799, as modified, for the purpose of improving flux density.

Response to Arguments

4. Applicant's arguments filed 5/1/03 have been fully considered but they are not persuasive.

Applicant argues that:

[1] Kanekiyo et al. and Kanekiyo et al. are non-analogous art;

[2] There would have been no motivation to combine the materials disclosed in Kanekiyo et al. with the materials disclosed in Kugimiya et al.

[3] JP 2-226799 does not remedy the deficiencies of Kanekiyo et al. in view of Kugimiya et al.

Art Unit: 2832

Examiner disagrees.

Regarding [1], in response to applicant's argument that Kanekiyo et al. and Kugimiya et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Kanekiyo et al. and Kugimiya et al. discloses a composite magnetic body.

Regarding [2], in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kugimiya et al. discloses the benefit of using a specific resistivity.

Regarding [3], JP 2-226799 discloses the specific coil design.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

Art Unit: 2832

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group is (703)872-9318 before the final office action, if the response is after final office action the fax number is (703)872-9319.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

July 13, 2003

Tuyen T. Nguyen